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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,282	04/24/2001	Geoffrey B. Rhoads	P0359	5545

23735 7590 05/21/2004  
DIGIMARC CORPORATION  
19801 SW 72ND AVENUE  
SUITE 250  
TUALATIN, OR 97062

EXAMINER

COUSO, JOSE L

ART UNIT	PAPER NUMBER
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2621

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/842,282

**Applicant(s)**

RHOADS ET AL.

**Examiner**

Jose L. Couso

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-21 and 26-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 25-35 been renumbered 26-36. That is there are two number 25 claims. The second number 25 claim has been renumbered 26. Originally numbered claims 26-35 have been renumbered 27-36.

Applicant should refer to the newly numbered claims in all future communications and amendments in order to avoid confusion and to ensure proper entry.

***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-7, drawn to a method of managing inventory, classified in class 705, subclass 28.
  - II. Claims 8-9, drawn to a monetary object for use in commerce, classified in class 209, subclass 534.
  - III. Claims 10-15, drawn to a method of determining the size of a monetary object, classified in class 382, subclass 138.
  - IV. Claims 16-21, drawn to a managing documents, classified in class 705, subclass 50.

- V. Claims 22-25, drawn to a method of printing documents in a network, classified in class 358, subclass 1.1.
- VI. Claims 26-31, drawn to a method of verifying a ticket stored on a handheld computing device having a display to display the ticket, classified in class 713, subclass 176.
- VII. Claims 32-34, drawn to a method of gaining entry to an event or movie, classified in class 283, subclass 53.
- VIII. Claim 35, drawn to a handheld computing device having a set of microlens, classified in class 382, subclass 313.
- IX. Claim 36, drawn to a method of identifying a handheld device, classified in class 382, subclass 141.

3. Inventions Groups I through Group IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group II has separate utility such as a monetary object used in commerce. See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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5. During a telephone conversation with Mr. Joel Meyer April 14, 2004 a provisional election was made without traverse to prosecute the invention of Group V, claims 22-25. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-21 and 26-36 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Detailed Action***

6. Claims 22-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 6,694,043. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are directed towards similar subject matter including watermarks, database and printing documents.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 22-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Hecht (U.S. Patent No. 5,901,224).

With regard to claim 22, Hecht describes associating in the database a unique identifier that is digitally watermarked within a physical document with an electronic

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copy of the document (see figure 1, elements 50 and 52 and refer for example to column 6, lines 42-55 column 8, lines 48-54); decoding the digital watermark with the watermark decoding device to retrieve the unique identifier (see figure 1, elements 32 and 34, and refer for example to column 6, lines 57-66); determining the associated electronic copy of the document (refer for example to column 6, line 66 through column 7, line 4); and rendering the electronic copy of the document to the printing device (refer for example to column 6, line 66 through column 7, line 4). Hecht clearly states in the descriptive portion of the specification, namely column 8, lines 1-46, that he is using digital watermarks.

With regard to claim 24, Hecht describes wherein the printing device is a printing device located closest to the watermark decoding device (see figure 1, element 56 and refer for example to column 6, line 66 through column 7, line 4).

As to claim 25, Hecht describes wherein the database comprises a database (see figure 1, elements 50 and 52).

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ramsay et al., Chow et al., Bloomberg ('686) and ('176), Erickson and Schneck et al. all disclose systems similar to applicant's claimed invention.

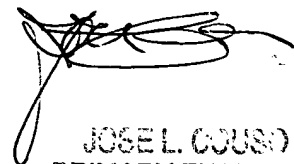
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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jose L. Couso whose telephone number is (703) 305-4774. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Boudreau can be reached on (703) 305-4706. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jlc  
May 10, 2004



JOSE L. COUSO  
PRIMARY EXAMINER